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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,166	09/14/2000	Thomas John Bitove	T8-465969CIP:DDH	9770

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CANADA

EXAMINER
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BARNIE, REXFORD N

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/662,166

Applicant(s)

BITOVE ET AL.

Examiner

REXFORD N BARNIE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 24 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 7,9,10,15-18,20,23-27,29-34 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 7,9,10,15-18,20,23-27,29-34 and 36-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 9-10, 15-18, 20, 23-27, 29, 30, 38-40, 42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woynoski et al. (US Pat# 6,370,240) in view of Muehlberger et al. (US Pat# 5,696,908) and further in view of Keil (US2001/002345 A1) or Risafi et al. (US Pat# 6,473,500).

Regarding claims 7 and 15, Woynoski teaches an ATM system in (see column 2 lines 48-50) wherein a user can purchase a prepaid account wherein the ATM functions just like the conventional ATM machine in conjunction with a financial institution without having to contact a telephone service provider (see col. 2 lines 58-67). Further,

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Woynoski teaches that a user can purchase a prepaid account with any desired amount in (see col. 4 lines 22-27). A printing means can print a receipt with an account identifier. Note that there would be a plurality of PINS to be used by a plurality of subscribers as means of accessing prepaid telecommunication services. Woynoski teaches authentication of one's account identifier (inherently) to provide a prepaid or calling card to be charged to one's account. (see col.3 lines 22-25, lines 58-62, col. 6 lines 65-67). Woynoski fails to teach being able to select a desired service provider associated with a purchased card.

Muehlberger teaches a telephone debit card dispenser and method wherein a user can purchase a prepaid account by using one of a plurality of payment methods including cash, bank card or credit card in (see col. 1 lines 6-10). Furthermore, Muehlberger teaches that a user can select a desired prepaid account amount in addition to a desired service provider in (see column 4 lines 60-67, column 5 lines 13-17). According to Muehlberger, the card can be issued by a bank thus removing the need to contact a telephone carrier during a card issuing process in (see col. 6 lines 9-12 and col. 7 lines 25-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to give a user the option to purchase a prepaid account as desired thus being able to phone calls away from home and also, to reduce telephone expenses, an advantage known and associated with prepaid telephone cards.

In response to the applicant's argument that the combination lacks a host server which the examiner disagrees because the ATM machine would have to function in

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conjunction with a central server to function based on the disclosure in (see col. 3 lines 58-col. 4 line 8 of Woynoski).

But for the sake of argument, Kiel teaches a POS terminal which can be connected to a financial institution (host server, 23 of fig. 1) over any data communication network (see col. 3 lines 34-37) wherein a PIN can be transmitted to a user in (see col. 3 "section 0037"). Furthermore, Kiel teaches a host server which obviously have a common form or a standard format for storing or outputting information including PINs.

Risafi et al. teaches a system and method for using a prepaid card wherein a host server can transmit PIN information to a user at a terminal possibly ATM for a prepaid card purchase in (see col. 12 lines 29-51, col. 11 lines 48-50 and col. 7 lines 38-45). Furthermore, according to Risalfi, the user's terminal could communicate with the financial institution or issuer (102) over any communication network. If the terminal communicates with a financial issuer network, there would not be a need for a telecommunication network, it could be a LAN or any possible network without having to go a telephone service provider. The host server (card issuer) can forward a PIN to a user, also. Furthermore, Risalfi teaches a host server (issuer or bank server) which obviously have a common form or a standard format for storing or outputting information including PINs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either Risalfi or Kiel into that of the combination thus making it possible for a POS or financial institution to provide

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prepaid cards through its machines including ATM thus providing multi-services to a user via an ATM and saving users the need to go to a store to buy Prepaid cards.

Regarding claims 9-10, see the explanation as set forth in the rejection of claim 7 in addition to the fact that the combination teaches the possibility of being able to use a bank card such as taught by Woynoski or in (see col. 1 lines 6-10 of Muehlberger et al.) Wherein a use can use one of a plurality of options including cash, credit card or bank card in acquiring a prepaid account. The combination including Woynoski would obviously teach an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse. The combination teaches being able to validate a prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

Regarding claims 16-17 and 25-26, The combination teaches the possibility of being able to use a bank card such as taught by Woynoski or in (see col. 1 lines 6-10 of Muehlberger et al.) Wherein a use can use one of a plurality of options including cash, credit card or bank card in acquiring a prepaid account.

Regarding claim 18, The combination including Woynoski would obviously teaches an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse

Regarding claim 20, The combination teaches being able to validate a prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

Regarding claim 24, see the explanation as set forth in the rejection of claim 15-23.

Regarding claims 27 and 29-30, The combination including Woynoski would obviously teaches an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse. The combination teaches being able to validate a prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

Regarding claims 38-40, The combination including Kiel or Risalfi teaches a host server which interfaces a POS terminal or ATM.

Regarding claims 42 and 44, the combination teaches the claimed subject matter.

Regarding claim 45, Woynoski teaches an ATM system in (see column 2 lines 48-50) wherein a user can purchase a prepaid account wherein the ATM functions just like the conventional ATM machine in conjunction with a financial institution without having to contact a telephone service provider (see col. 2 lines 58-67). Further, Woynoski teaches that a user can purchase a prepaid account with any desired amount in (see col. 4 lines 22-27). A printing means can print a receipt with an account identifier. Note that there would be a plurality of PINS to be used by a plurality of

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subscribers as means of accessing prepaid telecommunication services. Woynoski teaches authentication of one's account identifier (inherently) to provide a prepaid or calling card to be charged to one's account. (see col.3 lines 22-25, lines 58-62, col. 6 lines 65-67). Woynoski fails to teach being able to select a desired service provider associated with a purchased card.

Muehlberger teaches a telephone debit card dispenser and method wherein a user can purchase a prepaid account by using one of a plurality of payment methods including cash, bank card or credit card in (see col. 1 lines 6-10). Furthermore, Muehlberger teaches that a user can select a desired prepaid account amount in addition to a desired service provider in (see column 4 lines 60-67, column 5 lines 13-17). According to Muehlberger, the card can be issued by a bank thus removing the need to contact a telephone carrier during a card issuing process in (see col. 6 lines 9-12 and col. 7 lines 25-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to give a user the option to purchase a prepaid account as desired thus being able to phone calls away from home and also, to reduce telephone expenses, an advantage known and associated with prepaid telephone cards.

In response to the applicant's argument that the combination lacks a host server which the examiner disagrees because the ATM machine would have to function in conjunction with a central server to function based on the disclosure in (see col. 3 lines 58-col. 4 line 8 of Woynoski).



But for the sake of argument, Kiel teaches a POS terminal which can be connected to a financial institution (host server, 23 of fig. 1) over any data communication network (see col. 3 lines 34-37) wherein a PIN can be transmitted to a user in (see col. 3 "section 0037"). Furthermore, Kiel teaches a host server which obviously have a common form or a standard format for storing or outputting information including PINs.

Risafi et al. teaches a system and method for using a prepaid card wherein a host server can transmit PIN information to a user at a terminal possibly ATM for a prepaid card purchase in (see col. 12 lines 29-51, col. 11 lines 48-50 and col. 7 lines 38-45). Furthermore, according to Risalfi, the user's terminal could communicate with the financial institution or issuer (102) over any communication network. If the terminal communicates with a financial issuer network, there would not be a need for a telecommunication network, it could be a LAN or any possible network without having to go a telephone service provider. The host server (card issuer) can forward a PIN to a user, also. Furthermore, Risalfi teaches a host server (issuer or bank server) which obviously have a common form or a standard format for storing or outputting information including PINs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either Risalfi or Kiel into that of the combination thus making it possible for a POS or financial institution to provide prepaid cards through its machines including ATM thus providing multi-services to a user via an ATM and saving users the need to go to a store to buy Prepaid cards.

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Claims 31-34, 36, 37 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woynoski et al. (US Pat# 6,370,240) in view of Muehlberger et al. (US Pat# 5,696,908) and further in view of Risalfi or Kiel and further in view of Fougnyes et al. (US Pat# 5,722,067).

Regarding claims 31, see the explanation as set forth in the rejection of claim 1 in addition to the fact that the account can be used for prepaid telephony services. The combination fails to teach the ability of being able to associate a telephone number or ANI with a prepaid account.

Fougnyes teaches a security telecommunications system wherein the ANI associated with a wireless terminal could be used as means of triggering a pre-paid account when a call is made through a network (see column 3 line 37-column 4 line 34, column 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of ordinary skill in the art at the time the invention was made to incorporate the teaching of Fougnyes into that of Clark thus making it possible to make prepaid telephone calls without having to dial the account number but be able to do so based on simply the received ANI associated with the telephone which saves a user the time and effort to make the call.

Regarding claim 32-35, The combination including Woynoski would obviously teaches an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse. The combination teaches being able to validate a

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prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

Regarding claims 36-37, The examiner takes official notice that it's notoriously well known in the mobile communication art to assign cell phone certain frequencies to operate by using TDMA, CDMA and so forth. Also, well known is the assignment of MINS and ESNs to wireless telephones for identification and billing purposes.

Regarding claim 41, The combination including Kiel or Risalfi teaches a host server which interfaces a POS terminal or ATM.

### ***Response to Arguments***

Applicant's arguments filed on 07/26/2004 have been fully considered but they are not persuasive.

The applicant argued that the claimed subject matter including receiving or storing information including PINs in a standard format or in a common form is not taught by the combination as set forth in the rejection.

The examiner strongly disagrees because the combination teaches being able to dispense PINs to customers for telephony usage after authentication of user's account identifier. Furthermore, the PINs would obviously need to have a standard or format compatible with the system on which it's stored.

Also, the combination including Kiel or Risalfi teaches a host server which can stored PINS and output PINs to users wherein the system would stored information in a format common to the system.

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applied reference deals with outputting PINs from ATMs.

Clark (US Pat# 6,081,791) teaches an ATM wherein one can perform financial transactions, buy prepaid cards or stamps.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **REXFORD N BARNIE** whose telephone number is (703)306-2744. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CURTIS KUNTZ can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRIMARY EXAMINER  
REXFORD BARNIE  
12/15/04.

*R. Barnie*  
REXFORD BARNIE  
PRIMARY EXAMINER